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09/703,277	10/31/2000	Harrison G. Purvis	24104	1667

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Bracewell & Patterson
P O Box 61389
Houston, TX 77208-1389

EXAMINER
CHOP, ANDREA MARIE

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 22

Application Number: 09/703,277

Filing Date: 10/31/00

Appellant(s): Purvis et al.

Jeffrey Whittle

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/26/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 12-22 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

A substantially correct copy of appealed Claims 12 and 14-16 appears on Pages A-1 and A-2 of the Appendix to the appellant's brief. The minor errors are as follows:

Claim 12, line 4, --a-- should be inserted after "to";

Claim 12, line 9, "on" should be changed to --in--;

Claim 12, line 10, "plant" should be changed to --plane--;

Claim 14, line 2, "lest" should be changed to --least--;

Claim 14, line 5, "aid" should be changed to --said--;

Claim 15, line 2, "aid" should be changed to --said--;

Claim 15, line 6, "plan" should be changed to --plane--;

and

Claim 16, line 5, "includes" should be changed to --inclines--.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Rejection Based upon Recapture - 35 USC § 251

1. Claims 12-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement,* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that appellant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 12-22 do not include the following claim limitations:

> "said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchion, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs."

Based on the telephone conversation with Appellant on September 30, 1997, these limitations were added to the claims to overcome the 102e/103 rejection, and thus the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

(11) Response to Argument

In response to Appellant's argument that the Recapture Doctrine is not applicable due to the change in law regarding Section 103(c), it is irrelevant that a change in the law regarding Section 103(c) has occurred after prosecution and allowance of the original application, i.e., the application on which this reissue case is based. At the time of prosecution of the original

application, the commonly owned, different inventor Section of 103(c) was still in effect and since that situation was present during prosecution of the original application, this law was appropriately applied by the Examiner during prosecution of the original application.

The Examiner agrees with Appellant that a reissue application is a remedial tool which may be used to remedy certain situations, however, Appellant is still bound by the laws which are applicable during prosecution of the reissue application, and in this instance, the recapture law, 35 U.S.C. 251 is applicable.

In response to Appellant's arguments regarding fairness and equity, Appellant is reminded that during prosecution of the original application, the claims were amended to overcome the Section 103(c) rejection, and the public was informed of the scope of the claims when the original Application was patented; to now broaden appellant's claims in the reissue with subject matter that appellant previously surrendered during the prosecution of the original application is against public policy with respect to fairness and equity.

In response to Appellant's discussion that Appellant's prior attorney had chosen an option during prosecution of the original application that Appellant's present attorney would not have chosen is moot; choices were available to Appellant at the time of prosecution of the original application, and a decision was made to proceed in a particular fashion. Appellant appears to be attempting to try and go back in time and choose a different option, however, no such choice is available to appellant any longer, since prosecution of the original application has closed and the original application has issued into a patent.

In response to Appellant's argument that the Reissue Application should be examined based upon amended Section 103(c), the Examiner agrees; and as such, it is pointed out to Appellant that no Section 103(c) rejection has been applied in this reissue application, since the amended Section 103(c) is not applicable.

As pointed out by Appellant , MPEP Section 706.02 (l) (1) clearly states: "The recapture doctrine prevents the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made." And the Examiner has applied the recapture doctrine in this reissue application since this is exactly the situation in this reissue application.

In response to Appellant's discussion of the prosecution history of the original application and discussion of the "error" made by Appellant's prior attorney, i.e., the incorporation of subject matter from dependent claims which were not subject to the Section 102e/103 rejection rather than the filing of an affidavit under Section 1.132, it is pointed out that a choice was presented to Appellant's prior attorney during prosecution of the original application, and a choice was made by Appellant's prior attorney. Whether Appellant's present attorney believes that choice to be the wrong choice is moot at this point in time, since it is not possible to go back in time and redecide a different course of action.

In response to Appellant's arguments that Appellant never admitted that the broader scope of the claims was not patentable, the Examiner disagrees. The broader scope of the claims were rejected under a 102(e)/103 rejection, and appellant's prior attorney amended those claims to overcome that rejection; as such, Appellant has indeed admitted that the broader scope was not patentable.

In summary, it is against fundamental principles of fairness and equity to the public to allow Appellant to recapture subject matter that was surrendered during prosecution of the original application. And clearly such a situation is present in this reissue application, and the Examiner has appropriately applied the doctrine of recapture to this reissue Application and has rejected the claims accordingly.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AC
AMC
9/5/02

J. J. SWANN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Conferees
J.S. JS.
A.K. AK.

Allen Dyer Doppelt Milbrath & Gilchrist PA
PO Box 3791
Orlando FL 32802-3791